



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,988	11/18/2003	James J. Fitzgibbon	5569/79076	4889
22242 7590 07/17/2008 FITCH EVEN TABIN AND FLANNERY 120 SOUTH LA SALLE STREET SUITE 1600 CHICAGO, IL 60603-3406				
EXAMINER HOLLOWAY III, EDWIN C				
ART UNIT		PAPER NUMBER		
2612				
MAIL DATE		DELIVERY MODE		
07/17/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/715,988

Applicant(s)

FITZGIBBON ET AL.

Examiner

Edwin C. Holloway, III

Art Unit

2612

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4, 7, 11, 12, 14, 17, 18 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4, 7, 11-12, 14, 17-18 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

EXAMINER'S RESPONSE

1. Applicant's submission filed on 4-18-2008 has been entered. Claims 1-2, 4, 7, 11-12, 14, 17-18 and 21 are pending. The examiner has considered the new presentation of claims and applicant's arguments in view of the disclosure and the present state of the prior art. And it is the examiner's position that the claims are unpatentable for the reasons set forth in this Office action:

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

3. Claims 1-2, 4, 7, 11-12, 14, 17-18 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has not identified support for the amended claims in the specification as originally filed, nor has applicant stated that no new matter has been added by the amendment. Support is lacking for at least the wirelessly coupling in claims 1 and 11 because figs 1 shows wired coupling

of close only button 26 and Fig. 5 shows wired coupling of keypad 506 and button 512.

Applicant should specifically point out support in the original disclosure for the new or amended claims. See MPEP 714.02 and 2163.06.

Claim Rejections - 35 USC § 102 & 103

4. Claims 1-2, 4, 11-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan (US 4408251) in combination with Tolson (US 3337992).

Regarding claims 1 and 11, Kaplan discloses an entry control system (100) for permitting authorized users to access a controlled area by moving a barrier, comprising:

a push-button switch 38 generating a coded electrical signal when actuated by a user (col. 4, lines 47-61) and the button operating as a close button generating a close signal (col. 10 lines 56-63);

an entry request device (keyboard 20, col. 4, lines 47-61) for accepting a user authorization code (coded signal sequence, col. 5 lines 9-26);

a controller 22 operably coupled to the entry request device and the close button having an output (fig. 1, col. 5 lines 9-26),

such that the controller receives and authenticates the

authorization code (col. 5 lines 9-26) and wherein the close button and the entry request device are disposed in a housing (keyboard housing mounted on door jam in fig 1 and col. 4 lines 47-61, and the receipt of the close signal from the close button automatically causes the controller to issue a close barrier signal at the output in order to close the barrier without the need to authenticate any user authorization code (col. 10 lines 56-63).

Kaplan discloses in col. 10 lines 56-63 that pressing single button may be sufficient to close the door, while pressing a sequence of at least three button inputs is required to authenticate the user to open the door. The single button for closing the door is a close button without authentication as interpreted in light of applicant's disclosure (pg. 9 lines 19-34 and col. 11 lines 3-18).

Kaplan differs from claims 1 and 11 by disclosing a wired connection between keypad 20 and controller 22 instead of the wireless coupling of applicant's claims.

Tolson discloses analogous art remotely controlled closures wherein wired paths in figs 2-6 may be replaced with any other suitable paths such as wireless radio signals of Fig. 7. See col. 3 lines 53-62.

Regarding claims 1 and 11, it would have been obvious to

one of ordinary skill in the art at the time the invention was made to have replaced the wired path between the keypad 20 and controller 22 of Kaplan with a wireless path in view of Tolson disclosing to replaces wired paths with wireless paths in analogous art remote controlled closures for the same purpose of communicating selection signals to a controller (programmer in Tolson). The combination is further suggested by Kaplan disclosing a radio receiver 32.

Regarding claims 2 and 12, a barrier operator (motor 28) communicatively coupled to the controller at the output, the barrier operator receiving the close barrier signal is disclosed in col. 5 lines 9-26.

Regarding claims 4 and 14, the entry request device is a small keyboard (20, col. 4 lines 39-61) also called a keypad.

Regarding claim 8, a detector (radio receiver 32) for detecting an RF-ID (radio signal), and wherein the close barrier signal is not transmitted unless the controller detects an RF-ID (col. 5 lines 27-37).

5. Claims 1-2, 4, 8, 11-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan (US 4408251) in combination with Heitschel (US005576701A).

Kaplan was discussed above to include all the limitations of claims 1 and except that Kaplan discloses a wired connection

between keypad 20 and controller 22 instead of the wireless coupling of applicant's claims.

Heitschel discloses an analogous art garage door operator system with controller 78 wireless coupled to keypad transmitter 25. See figs. 1, 7 and 9. Wireless coupling allows remote access, while input of a four digit code on the keypad prevents access by a theft. See figs. 1, 7 9 and col. 6 lines 16-30.

Regarding claims 1 and 11, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have replaced the wired path between the keypad 20 and controller 22 of Kaplan with a wireless path in view of Heitschel disclosing wireless RF signals from a keypad transmitter for the same purpose of communicating selection signals to the controller wherein entry of a code by key presses prevents use by a thief. The combination is further suggested by Kaplan disclosing a radio receiver 32.

6. Claims 7 and 17-18 are ejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan (US 4408251) in combination with Tolson (US 3337992) or Heitschel (US005576701A) as applied above in combination with Matsuoka (US 4365250).

Regarding claims 7 and 17-18, Kaplan does not expressly disclose the limitation of wherein the close button changes function after a predetermined time period.

Matsuoka discloses an analogous art garage door operation control apparatus wherein the close button changes function after a predetermined time period. Operation of a command changes function from downward movement (302, close) to stationary (303, stop) in response to a sequence of operation command inputs (col. 4 lines 44-64). The operation command may be input by a pushbutton switch with a time delay TM4 between each command (col. 8 lines 3-33). Therefore, the function changes after time TM4. This allows manual stopping and reversing direction of the door. Such operation may be provided to for safety.

Regarding claims 7 and 17-17, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in the combination applied above changing the button function from close/down to stop after a time period as disclosed in Matsuoka to allow stopping the door for safety and/or for partial closing.

7. Claims 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan (US 4408251) in combination with Tolson (US 3337992) or Heitschel (US005576701A) as applied above in combination with Ligman (US 4206491) or Lee (US 4369399) or Apple (US 4305060).

Regarding claim 21, Kaplan does not expressly disclose the

limitation wherein the generation of the close barrier signals is delayed for a predetermined time after the actuation of the close button.

Ligman discloses an analogous art entry system that may be used with garage door operation (col. 8 lines 10-12) wherein a debounce delay 106 is provide between user input and generation of a control signal to prevent false input due to low power or noisy signal. See fig. 8 col. 7 lines 9-35.

Lee discloses an analogous art garage door controller with debounce eliminator 148 connected to button 110 that provides a delay as in Ligman. see fig. 10 and col. 11 lines 51-62.

Apple (US 4305060) discloses an analogous art garage door operator where a delay is provided to allow comparison of a plurality of input codes so that a plurality of matches are required and a limited number of mismatches are allowed before a control signal is output. This maintains security while allowing for interference. See the abstract and col. 2 line 60 - col. 3 line 10.

Regarding claim 21, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in the combination applied above the claimed delay in view of the delay in Ligman, Lee or Apple to avoid false input due to low power, noise or interference.

Response to Arguments

7. Applicant's arguments with respect to claims 1-2, 4, 7, 11-12, 14, 17-18 and 21 have been considered but are not persuasive and/or are moot in view of the new ground(s) of rejection.

The objection to claim 4 has been obviated by applicant's amendment.

A new 35 USC 112 rejection was necessitated by applicant's amendment. Applicant should point to support in the original disclosure and state that no new matter has been added.

New prior art rejections were necessitated by applicant's amendment. In response to the new limitation of a wireless coupling, new rejections has been made relying on Tolson or Heitschel to disclose wireless coupling to a controller for closure or garage door.

The argument that Kaplan always uses wired connection with control 22 in order to prevent tampering is not persuasive because it is not the wires that prevent tampering but the coded signals. The prior art in col. 1 lines 37-57 of Kaplan includes wired coupling that is easily tampered with by shorting the wires. The invention of Kaplan reduces such tampering by using a coded signal sequence responsive to keypad/keyboard operation.

The argument that neither Matsuoka, Ligman, Lee nor Apple remedy the deficiency of Kaplan lacking wireless coupling is not

persuasive because the combination of Kaplan with Tolson or Heitschel remedies the deficiency.

The argument that Apple does not even relate to moveable barrier operators is incorrect because Apple refers to automatic garage door operators in the ABSTRACT. Further, Apple includes code select 5 in the form of a plurality of two position switches that is analogous to a keypad or keyboard.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sanders (US 4754255) and Murray (US006903650B2) disclose access systems with keypad transmitters.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will

expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

CONTACT INFORMATION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (571) 272-3058. The examiner can normally be reached on M-F from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Zimmerman, can be reached on (571) 272-3059.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

7/17/2008
(571) 272-3058

/Edwin C. Holloway, III/
Primary Examiner, Art Unit 2612